

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCE

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Ex parte MICHAEL A. EPSTEIN

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Appeal No. 2006-1104  
Application No. 09/548,728<sup>1</sup>

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ON BRIEF

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Before THOMAS, RUGGIERO and SAADAT, Administrative Patent Judges.  
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1, 2, 4, 5 and 11-14. Claims 6-10 are allowed and claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

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<sup>1</sup> Application for patent filed April 13, 2000, which claims the filing priority benefit under 35 U.S.C. § 119 of Provisional Application No. 60/131,993, filed April 30, 1999.

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independent form including all of the limitations of the base claim and any intervening claims.

We reverse.

#### BACKGROUND

Appellant's invention is directed to techniques for discouraging or limiting the number of copies that can be made from a legitimate copy of the copy-protected material.

Representative independent claim 1 is reproduced below:

1. A method for limiting simultaneous copies of content material, comprising:  
communicating a copy of the content material to a receiving device,  
communicating a security challenge to the receiving device when the copy of the content material is communicated to the receiving device, and  
receiving a security response, based on the security challenge, from the receiving device when the copy of the content material is removed from the receiving device.

The Examiner relies on the following reference in rejecting the claims:

Ananda et al. (Ananda)	5,638,513	Jun. 10, 1997
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Claims 1, 2, 4, 5 and 11-14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ananda.

Rather than reiterate the opposing arguments, reference is made to the briefs (filed September 2, 2005 and January 3, 2006) and answer (mailed November 15, 2005) for the respective

positions of Appellant and the Examiner. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the briefs have not been considered (37 CFR § 41.37(c)(1)(vii)).

#### OPINION

The main point of contention is based on whether Ananda teaches the claimed "receiving a security response, based on the security challenge," as argued by Appellant (brief, page 5). The Examiner interprets the claimed "security response" as a security message informing a user that access is being terminated (answer, sentence bridging pages 4-5) and equates it with the message indicating that the execution of the application on the remote computer is terminated (answer, page 4). To support this position, the Examiner relies on column 4, lines 29-30; column 10, lines 29-30; column 12, lines 65-67; and column 14, lines 11-14 of the reference (id.). Appellant argues that in Ananda, the response, or the termination message, is unrelated to the challenge or the request for ID as the message is sent to the user, regardless of the user's ID password (reply brief, page 3).

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every

element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

After a review of Ananda, we agree with Appellant's assertion that the claimed "receiving a security response, based on the security challenge" is different from the message sent to the user when the execution of the application is terminated. Ananda actually includes a header software with the content or the software that includes a rental security manager (col. 9, lines 52-60) which determines whether the user may continue to use the software based on a series of tests for determining continued connection between the central rental facility and the remote user computer (col. 9, lines 66 through col. 10, line 8). When the test fails, the execution of the application is terminated and the user is notified (col. 10, lines 8-10).

Therefore, although some kind of response is sent when the execution of application is terminated, as argued by Appellant, it is sent to the user and not between the rental facility and the user's device. Further, this notification is not based on

the security challenge that the Examiner (answer, page 4) identified as the unique user identification password the user has to provide to access the system in Ananda (col. 3, lines 12-16).

We note that independent claim 11 also requires that a security response based on the security challenge be sent to the check-out/check-in device. As discussed above, Ananda does not provide receiving such security response based on the security challenge from the receiving device and therefore, cannot anticipate any of independent claims 1 and 11, nor claims 2, 4, 5 and 12-14, dependent therefrom.

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## CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1, 2, 4, 5 and 11-14 under 35 U.S.C. § 102 is reversed.

REVERSED

JAMES D. THOMAS  
Administrative Patent Judge

*Joseph F. Ruggiero*  
JOSEPH F. RUGGIERO  
Administrative Patent Judge

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